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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,354	06/30/2004	Masayo Higashiyama	2004_1016A	2612

513 7590 05/02/2012
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EXAMINER

FRAZIER, BARBARA S

ART UNIT	PAPER NUMBER
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1611

NOTIFICATION DATE	DELIVERY MODE
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05/02/2012

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com
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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/500,354	Applicant(s) HIGASHIYAMA, MASAYO
	Examiner BARBARA FRAZIER	Art Unit 1611

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 April 2012 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.
NO NOTICE OF APPEAL FILED

1. ☒ The reply was filed after a final rejection. No Notice of Appeal has been filed. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance;
 (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114 if this is a utility or plant application. Note that RCEs are not permitted in design applications. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action; or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

c) ☐ A prior Advisory Action was mailed more than 3 months after the mailing date of the final rejection in response to a first after-final reply filed within 2 months of the mailing date of the final rejection. The current period for reply expires _____ months from the mailing date of the prior Advisory Action or SIX MONTHS from the mailing date of the final rejection, whichever is earlier.

Examiner Note: If box 1 is checked, check either box (a), (b) or (c). ONLY CHECK BOX (b) WHEN THIS ADVISORY ACTION IS THE FIRST RESPONSE TO APPLICANT'S FIRST AFTER-FINAL REPLY WHICH WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. ONLY CHECK BOX (c) IN THE LIMITED SITUATION SET FORTH UNDER BOX (c). See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) or (c) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendments filed after a final rejection, but prior to the date of filing a brief, will not be entered because

a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

b) ☐ They raise the issue of new matter (see NOTE below);

c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): (a) ☐ will not be entered, or (b) ☒ will be entered, and an explanation of how the new or amended claims would be rejected is provided below or appended.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing the Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

STATUS OF CLAIMS

14. The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3,5-10,12 and 13.

Claim(s) withdrawn from consideration: _____.

/Joanne Hama/ Primary Examiner, Art Unit 1632	/B. F./ Examiner, Art Unit 1611
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Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments are not persuasive for overcoming the rejection. Upon further reconsideration, it is noted that, while Applicant's data shows a critical range in which sodium, potassium, or calcium chloride impart a light-stabilization effect to a bepotastine-containing composition (Example 1 of specification), the range of amounts now claimed (i.e., 0.2 to 1.2% w/v) still sufficiently overlaps that of Lehmuassari (0.01 to 2.0%) that one skilled in the art would still arrive at such a range by routine experimentation, and would be motivated to do so for reasons stated in the previous Office action (see pages 3-4 of Office action mailed 11/30/11). Additionally, such amounts would necessarily be a light-stabilizing effective amount, absent evidence to the contrary. Thus, while the data does present evidence of nonobviousness in the form of a critical range of amounts, the evidence is not sufficient to outweigh the prima facie case of obviousness. Additionally, upon further reconsideration, Applicant's arguments regarding the presence of the Carbopol polymer in Lehmuassari are not sufficient for overcoming the prima facie case of obviousness because, while Applicant's evidence teaches Carbopol polymers, such as those taught in Lehmuassari, degrade in the presence of light, Applicant's evidence does not show that such a polymer, when present in the composition of the combined references, would cause the composition to not be light-stable. Thus, it is not clear that such a polymer would affect the basic and novel characteristics of the claimed composition. Applicant's argument regarding difference of problems and difference in compounds between Lehmuassari and the claimed invention are not persuasive because the rejection is not based on Lehmuassari alone, but rather Kita (which teaches bepotastine) in view of Lehmuassari, and references can be combined for reasons other than Applicant's. Applicant's arguments regarding hindsight are not persuasive because, while it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, the rejection takes into account only knowledge which was within the level or ordinary skill at the time the invention was made, and does not include knowledge gleaned only from applicant's disclosure; therefore, such a reconstruction is proper.